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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,526	09/27/2001	Shinji Tomita	KPC-294	9267
23353	7590	12/19/2003	EXAMINER	
RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036			SHOSHO, CALLIE E	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 12/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/963,526

Applicant(s)

TOMITA ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-3

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Callie E. Shosho
Primary Examiner
Art Unit: 1714

Attachment to Advisory Action

1. Prior to setting forth the response, it is noted that applicants are correct in that there are 3 claims pending in the present application. The examiner inadvertently stated that there were 4 pending claims in the office action mailed 9/29/03.

2. Applicants' response filed 11/26/03 has been fully considered but it is not persuasive.

Specifically, applicants argue that the coating composition of Goldner et al. is used for metallic finish or overcoating of mono color while the present claims relate to coating composition for undercoat.

While there is no explicit disclosure in Goldner et al. that the composition is for undercoating, on the one hand, it is noted that, with respect to claim 1, the recitation in the claims that the composition is "for undercoat" is merely an intended use. Applicants attention is drawn to MPEP 2111.02 which states that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use. Given that Goldner et al. disclose composition as presently claimed, it is clear that the composition of Goldner et al.

would be capable of performing the intended use, i.e. for undercoat, presently claimed as required in the above cited portion of the MPEP.

On the other hand, it is noted that Goldner et al. disclose a coating method wherein the surface to be coated is first coated with primer, followed by coating composition, followed by topcoat. Applicants argue that the presently claimed coating composition is equivalent to the primer of Goldner et al. However, the present claims only require that the composition is an undercoat. Given that Goldner et al. disclose that the composition corresponding to the presently claimed coating is between the primer and the topcoat, the coating composition does function as an undercoat with respect to the topcoat.

Applicants also argue that the acrylic resin disclosed by Goldner et al. is different than the acrylic resin used in the present invention. However, given that Goldner et al. disclose acrylic resin with hydroxyl value, glass transition temperature, and molecular weight that overlaps that presently claimed, it is clear that the acrylic resin of Goldner et al. meets the limitations of the present claims.

Applicants also argue that there is no disclosure in Goldner et al. that the ratio of isocyanate group in the polyisocyanate to 1 equivalent of hydroxyl group in the acrylic resin is 2-4 equivalents. However, it is noted that col.2, lines 14-16 disclose that the polyisocyanate comprises two groups per molecule reactive with regard to the OH groups of the acrylic resin. This statement is further clarified in col.22, lines 56-59 of Goldner et al. where it is disclosed that the polyisocyanate has at least two groups per molecule reactive with one OH group of the acrylic resin. From these disclosures, it is clear that Goldner et al. teach that ratio of isocyanate equivalents to hydroxyl equivalents is 2:1.

Applicants also argue that col.18, lines 20-22 of Goldner et al. disclose thickeners that correspond to presently claimed component (C) but there is no disclosure of the amount of thickener utilized.

However, it is noted that presently claimed component (C) is resin fine particles. Goldner et al. disclose the use of polyurethane emulsion that encompasses this limitation. Further, Goldner et al. disclose that the polyurethane emulsion is present in ratio of 95:5 to 5:95 (col.12, lines 44-46) with respect to the acrylic resin. In light of this and given that the acrylic resin and polyurethane emulsion are present in the coating composition in an amount of 70-100% (col.2, line 6), it is calculated that the composition comprises, for instance, 3.5% polyurethane emulsion and thus, the amount of component (C) disclosed by Goldner et al. falls within the scope of the present claims.

Thus, it is the examiner's position that Goldner et al. remains a relevant reference against the present claims.

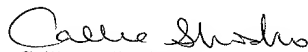
3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Application Number: 09/963,526

Art Unit: 1714

Page 5



Callie E. Shosho
Primary Examiner
Art Unit 1714

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12/12/03